

Appln. Serial No. 10/800,055
Amendment Dated October 9, 2008
Reply to Office Action Mailed June 9, 2008

REMARKS

In the Office Action dated June 9, 2008, claims 18-21 were rejected under 35 U.S.C. § 101; claims 1, 3-5, 8, 11, 13, 22, and 25-33 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2004/0176104 (Arcens) in view of U.S. Patent Application Publication No. 2001/0009544 (Vanttinen); claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Vanttinen, and further in view of Applicant's admitted prior art, U.S. Publication No. 2004/0180655 (Applicant's "admitted prior art"); claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Vanttinen, and further in view of Applicant's "admitted prior art;" claims 15-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens in view of Vanttinen, and U.S. Patent No. 6,195,557 (Havinis); claims 18-20 were rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens in view of Havinis; claim 21 was rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Havinis, and further in view of Vanttinen; and claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Vanttinen, and further in view of Havinis.

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REJECTION UNDER 35 U.S.C. § 101

Independent claim 18 has been amended to recite “[a]n article comprising at least one machine-readable storage medium containing instructions.” In view of this, it is believed that the Examiner’s § 101 rejection has been addressed, since claim 18 now specifically recites that the instructions are contained in a machine-readable storage medium. Therefore, withdrawal of the § 101 rejection is respectfully requested.

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REJECTION UNDER 35 U.S.C. § 103 OVER ARCENS AND VANTTINEN

It is believed that the rejection of independent claim 1 over Arcens and Vanttinen is defective.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

It is respectfully submitted that there existed no reason to combine the teachings of Arcens and Vanttinen. More specifically, there existed no reason to substitute the application-level location request (which is a non-paging message) of Arcens with the paging message of Vanttinen. Note that the mobile station 102 of Arcens contains a location application block 114, which can be self-contained and does not require interaction with an external network, or alternatively, may involve interaction with an external location request application 108 (see Fig. 1 at ¶ [0023] of Arcens). In the latter context, where a location request is received from the external application 108, such a location request is an application-to-application location request. This form of location request that involves communication of data between different applications (one in the mobile station, and another one external to the mobile station) would clearly not involve data carried in a paging message. In fact, since communication of application-level data is involved in Arcens, the location request sent by the external location request application 108 to the mobile station 102 would have to be carried as traffic, and more particularly, as traffic in a traffic channel (and not a paging message) of a wireless network to the mobile station of Arcens. In view of this, a person of ordinary skill in the art clearly would not have been prompted to replace the location request of Arcens with a paging message, as doing so would defeat the intended purpose of Arcens, which involves an application-to-application communication of application traffic.

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The secondary reference, Vanttinen, cited by the Office Action, refers to using a paging message from a BSS to a mobile station to request a location service. However, nowhere in Vanttinen is there any hint of any need to incorporate an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service. In fact, the focus of Vanttinen is on providing better quality of service in the context of a location service. *See, e.g.*, Vanttinen, ¶ [0065]-[0067]. Vanttinen provides no hint whatsoever that it would be desirable to incorporate into a paging message an indication of whether the paging message is related to an emergency-related location service or a law enforcement-related location service.

A person of ordinary skill in the art looking at the teachings of Arcens and Vanttinen would have been provided with two different solutions: (1) use an application-to-application location request (Arcens) or (2) use a paging message that does not contain any indication of whether the paging message is related to an emergency-related or law enforcement-related location service (Vanttinen). Therefore, a person of ordinary skill in the art would not have been prompted to combine the teachings of Arcens and Vanttinen to achieve the claimed subject matter.

Moreover, as conceded by the Office Action, Arcens fails to disclose communicating, to a mobile station, a paging message containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where the indication has a first state to indicate that the paging message is related to at least one of the emergency-related location service and the law enforcement-related location service. 6/9/2008 Office Action at 10. However, as explained above, Vanttinen also fails to disclose or hint at the above claimed feature. Therefore, the hypothetical combination of references would not have led to the claimed subject matter.

The obviousness rejection of claim 1 is therefore defective.

Independent claims 22 and 27 are allowable over the cited references for similar reasons.

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Independent claim 8 was also rejected as being obvious over Arcens and Vanttinen. With respect to claim 8, the Office Action conceded that Arcens fails to disclose communicating a paging message containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where communicating the paging message includes sending a paging request containing the indication from a mobile switching center to a base station. 6/9/2008 Office Action at 9. Instead, the Office Action relied upon Vanttinen as disclosing the communication of such a paging message. *Id.*

Vanttinen does not disclose or hint at the claimed subject matter that is missing from Arcens. As explained above, Vanttinen does not teach or hint at providing an indication of whether a paging request is related to an emergency-related location service or a law enforcement-related location service. Vanttinen assumes that any requestor can obtain the location of the mobile station to provide "better" quality of service, and therefore, such an indication would not be needed. On the other hand, Arcens is related to an application-to-application location request that is sent in a traffic channel, which is quite different from sending the location request in a paging message. Therefore, no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of Arcens and Vanttinen to achieve the subject matter of claim 8.

The obviousness rejection of claim 8 is therefore also defective.

REJECTION UNDER 35 U.S.C. § 103 OVER ARCENS AND HAVINIS

Independent claim 18 was rejected as purportedly obvious over Arcens and Havinis.

It is respectfully submitted that no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings Arcens and Havinis. Note that claim 18 calls for a mobile station to receive messaging to cause the mobile station to move to a traffic channel of the wireless communications network in response to a callback by at least one of an emergency services entity and a law enforcement entity; receive a location request on the traffic channel containing an indication that the location request is related to at least one of an emergency-related location service and a law enforcement-related location service; and send location information of the mobile station in response to the location request.

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Havinis does not contemplate at all providing any messaging to the mobile station to cause the mobile station to send location information. As specifically taught by Havinis, it is the MLC 370 (*see* Fig. 3 of Havinis) that determines whether or not subscriber settings allow positioning of the subscriber. If not, then the MLC would deny a position request. However, if a location service of the subscriber is allowed, then messaging is sent from the MLC to the MSC, which in turn sends messaging to the BSC, which then uses several BTSs to determine the location of the mobile station. Note that no location request ever reaches the mobile station in the context of Havinis.

Therefore, since Havinis relates to subject matter that is quite different from Arcens, it is respectfully submitted that a person of ordinary skill in the art would not have been prompted to combine the teachings of Arcens and Havinis to achieve the claimed invention.

Therefore, the obviousness rejection of claim 18 is also defective.

REJECTION UNDER 35 U.S.C. § 103 OVER ARCENS, VANTTINEN, AND HAVINIS

In view of the arguments presented above with respect to the obviousness rejections over Arcens and Vanttinen, and Arcens and Havinis, it is respectfully submitted that the obviousness rejection of independent claim 15 is also defective.

As explained above, Vanttinen clearly fails to disclose a paging message that contains an indication that the paging message is related to at least one of the emergency-related location service and the law enforcement-related location service. Havinis also fails to provide such teaching. Therefore, even if Arcens were to be hypothetically combined with Vanttinen and Havinis, it is respectfully submitted that the hypothetical combination of the references would not have led to the claimed subject matter.

CONCLUSION


Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the defective obviousness rejections of base claims, the obviousness rejections of dependent claims have also been overcome.

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Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0118US).

Respectfully submitted,

Date: OCT 9, 2008



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